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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/319,688 06/09/99 HISHINUMA

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IM22/1017

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EXAMINER

J GEORG SEKA
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

TALBOT, R

ART UNIT

PAPER NUMBER

1762

DATE MAILED:

10/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application N .

09/319,688

Applicant(s)

HISHINUMA ET AL.

Examiner

Brian K Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 30-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 12-27 is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 06 August 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The amendment and substitute specification, filed 8/6/01, have been considered and entered. Claims 1-27 and 30-33 remain in the application.

This application contains claims 1-11 and 30-33 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's election with traverse of Group II, claims 12-27 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that there is no burden to search the other groups. This is not found persuasive because issues that arise in prosecuting product claims as well as different processes are different and this constitutes a burden.

The requirement is still deemed proper and is therefore made FINAL.

In light of the proposed drawing corrections, filed 8/6/01, the objection to the drawings has been withdrawn. The Examiner has approved the drawings.

In light of the amendment filed 8/6/01, the 35 USC 112 rejections have been withdrawn.

Claim Rejections - 35 USC § 103

Claims 12-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 04-121,964 in combination with JP 04-169,067 and Hazbun (4,791,079) further in combination with Matsuzaki (5,474,800).

JP 04-121,964 teaches a fuel electrode for solid electrolyte fuel cells. The fuel cell electrode is a cerment comprising Ni-CeO₂-YSZ.

JP 04-121,964 fails to teach a transition metal as well as the Ce compound having a metal oxide dissolved therein.

JP 04-169,067 teaches the addition of an alkaline earth metal or rare earth element along with Nickel and Cerium in producing a fuel cell electrode. Hazbun (4,791,079) teaches doping a stabilized zirconia with titanium or vanadium produces improvement in ion and electron conductivity in fuel cell electrodes.

Therefore, it would have been obvious at the time the invention was made to have modified JP 04-121,964 electrode cerment with the components as evidenced by JP 04-169,067 and Hazbun (4,791,079) because of the improvement in conductivity displayed by the electrode.

JP 04-121,964 in combination with JP 04-169,067 and Hazbun (4,791,079) fails to teach forming the fuel electrode with metallo-organic precursors.

Matsuzaki (5,474,800) teaches forming Ni-YSZ electrode fuel cells by mixing metallo-organic precursors of the components, hydrolysis and annealing to form the electrode. The metallo-organic precursors are metal octylates and the nickel is introduced as a powder. The electrode paste is screen printed on the electrolyte.

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Therefore, it would have been obvious for one skilled in the art at the time the invention was made to have modified JP 04-121,964 in combination with JP 04-169,067 and Hazbun (4,791,079) cerment by utilizing metalo-organic precursors and oxide powders because of the expectation of achieving similar results.

Response to Amendment

Applicant's arguments filed 8/6/01 have been fully considered but they are not persuasive.

Applicant argued that the restriction requirement is not proper.

The Examiner has addressed this issue above.

Applicant argued that the 35 USC 112 rejections were not proper.

The Examiner has withdrawn the rejection in light of the arguments and showings by Applicant.

Applicant argued that the combination rejection was based on improper hindsight.

In response to Appellant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the

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time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Tuesday-Friday 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-6357 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.



Brian K Talbot
Primary Examiner
Art Unit 1762

BKT
October 16, 2001